

Application No. 10/058640
Page 6

Amendment
Attorney Docket No. S63.2B-10015-US01

REMARKS

This Amendment is in response to the Office Action dated March 9, 2004, wherein claims 1, 2, 4-5, 10, 11, 13 and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,935,162 to Dang; claims 8, 9 and 17 were rejected under 35 U.S.C. §103(a) as being obvious over Dang in view of U.S. 6,019,789 to Dinh et al (Dinh); and claims 18-22 were rejected under 35 U.S.C. 103(a) as being obvious over Dinh in view of Dang..

The following comments are presented with the same section headings and in the same order as the Office Action.

Election/ Restrictions

Applicants acknowledge and appreciate the reconsideration of claim 10, 11, 13-15 and 17. Applicants acknowledge the withdrawal of claims 3, 7, 12 and 16 as being directed to a non-elected species. Applicants however, reserve the right to prosecute the withdrawn claims in a subsequent divisional or continuation Application.

Claim Rejections – 35 U.S.C. §102

In the Office Action claims 1, 2, 4, 5, 10, 11, 13 and 14 were rejected under §102(b) as being anticipated by Dang.

Applicants respectfully assert however that the Dang reference does not teach all of the elements of the instant claims.

Independent claim 1 in part describes a stent having serpentine bands, wherein each serpentine band has proximal and distal ends and *consists* of a plurality of interconnected struts of substantially the same length. In order for the serpentine bands of Dang to be viewed as consisting of interconnected struts, then the serpentine bands must be viewed as including struts of two different lengths, in contrast to the description in claim 1 (see FIG. 2: bands 20a-e; and FIG. 7: bands 320a-d). On the other hand, if the bands are considered to consist of only the struts of the same length, than the struts would not be interconnected as claim 1 recites.

In addition, claim 1 also describes that the stent has wishbone connectors each of which have an elongate portion, which has a proximal end and a distal end, wherein the proximal end has two legs extending from the proximal end to one of the two serpentine bands and

Application No. 10/058640
Page 7

Amendment
Attorney Docket No. S63.2B-10015-US01

wherein the distal end has two legs extending from the distal end to the other of the two serpentine bands.

In the Dang reference, the stent depicted in FIGs. 2 and 7 may be considered as having wishbone connectors similar to those mentioned in the preceding paragraph. When considered as such, the "two legs" of the connectors which extend from the proximal end and distal end respectively of the "elongate portion" must be considered to be a portion of the adjacent serpentine bands, as it is the "two legs" of each end of the connector which allow the struts of the serpentine bands of Dang to be interconnected as recited. In other words, the struts of a serpentine band of Dang can not be considered interconnected unless the two legs on a given end of the wishbone connector are considered as part of the serpentine band. As discussed above, however, if the legs of the connector are part of the band, then the band clearly would not be considered as *consisting* of interconnected struts of substantially the same length.

Claim 1, as well as independent claim 10 of the instant Application both include a description of the elongate element of each wishbone connector being disposed between adjacent serpentine bands in such a way so as to "not overlap longitudinally with either of the two serpentine bands". This aspect of the claimed stent may be seen in any of the various FIGs. 1-6 of the instant Application in that the elongate portion of each of the wishbone connectors does not extend sufficiently in a longitudinal direction to overlap any portion of an adjacent serpentine band and vice-versa (see also page 5, lines 10-13 of the Application as filed). This is not the case in Dang, wherein the elongate portion, such as is depicted in FIGs. 2 and 7 clearly longitudinally overlap both adjacent serpentine bands, in contrast to the instant claims.

Claims 1, 2, 4 and 5 depend from claim 1 and claims 11, 13 and 14 depend from claim 10.

In light of the above, the rejection to claims 1, 2, 4, 5, 10, 11, 13, and 14 is respectfully traversed.

Claim Rejections – 35 U.S.C. §103

In the Office Action claims 8, 9 and 17 were rejected under §103(a) as being obvious over Dang in view of Dinh.

Claims 8 and 9 depend from independent claim 1 and claim 17 depends from

Application No. 10/058640
Page 8

Amendment
Attorney Docket No. S63.2B-10015-US01

independent claim 10. As indicated above, Dang does not teach all of the elements of independent claims 1 and 10. Furthermore, there is no suggestion in Dang to modify the stent described therein to include all of the elements of the cited claims.

In the Office Action, Dinh is cited to provide the stated peak to wishbone ratio of instant claims 8 and 17 as well as the provision of bands having a width which exceeds the width of the wishbone connectors, as described in instant claim 9. The proposed inclusion of the selected elements of Dinh however, does nothing to address the failure of Dang to teach or suggest all of the elements of the instant claims. Even if the elements identified in Dinh are combined with Dang, the resulting hybrid device will fail to teach or suggest all of the elements of the instant claims. As such the rejection is respectfully traversed.

In the Office Action claims 18-22 were rejected under 103(a) as being obvious over Dinh in view of Dang.

Section 103 precludes hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. The courts have provided further assurance of an "as a whole" assessment of the invention under §103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination (See *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686, 1690 (CA FC 2004); see also *In re Rouffet*, 149 F.3d 1350, 1355-56 [47 USPQ2d 1453] (Fed. Cir. 1998)).

In rejecting the instant claims the Office Action seeks to combine the stent shown in FIG. 6C of Dinh with the connectors shown in FIG. 7 of Dang, which have connectors that have the proximal ends which are longitudinally and circumferentially offset from the distal ends. The motivation asserted in the Office Action for attempting the combination of Dang's offset connectors with the stent shown in FIG. 7 of Dinh is to "produce a stent having good longitudinal flexibility to maneuver through tortuous vessels."

Applicants respectfully assert that upon a review of the invention as a whole, this motivation is insufficient to provide one of ordinary skill in the art the impetus to attempt

Application No. 10/058640
Page 9

Amendment
Attorney Docket No. S63.2B-10015-US01

to make the proposed combination of features between Dinh and Dang.

In both references, a stated goal is to provide for a stent having improved longitudinal flexibility (see column 5, lines 41-45 of Dinh where it is stated that the stents described must have unit cells which provide the stent with sufficient flexibility to enable tracking of the stent through often tortuous vascular paths for placement at the treatment site; see also the abstract of Dang wherein the stent described is said to be provided with improved longitudinal flexibility). The references presumably meet their common goal with their respective stent designs. Thus, one of ordinary skill in the art would not be motivated by that same goal (e.g. to provide improved longitudinal flexibility) in order to attempt to combine features of the references in order to provide an additional stent design that would be created solely to meet the goal already and adequately addressed by the stent designs of the separate references.

It is only when the references are viewed through the lens of hindsight that any motivation to combine the references becomes apparent. As indicated above, the use of such hindsight is impermissible (see also *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

It must also be noted however, that regardless of any motivation to combine the references, Applicants assert that the proposed combination of references would require significant and possibly detrimental modification to at least the stent of Dinh if the connectors and 'second' serpentine band of Dinh were replaced with the offset connectors shown in FIG. 7 of Dang. One of ordinary skill in the art would recognize that the stent shown in FIG. 6C of Dinh is provided with first and second connectors 174 that are longitudinally opposite one another and not circumferentially offset. The connectors 174 are however provided in a repeating pattern of immediately adjacent connections. In addition, the second band 178 links the opposite connectors with a plurality of somewhat mushroom shaped members, which are uniformly arranged and oriented in a given band. One of ordinary skill in the art would not be able to merely replace this somewhat complex arrangement of connectors 174 and bands 178 with the circumferentially and longitudinally offset connectors of Dang without detrimentally affecting the structure and/or function of the Dinh stent. Such a substitution would require that the structure of Dinh be significantly modified beyond the scope of the invention (see *In re*

Application No. 10/058640
Page 10

Amendment
Attorney Docket No. S63.2B-10015-US01

Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) wherein the court determined that a prima facie case of obviousness has not been made when the intended purpose or function of one or both references are destroyed in an attempt to combine or modify them)).

In light of the above, the rejection is respectfully traversed.

CONCLUSION

In view of the foregoing it is believed that the present application, with claims 1, 2, 4, 5, 8-11, 13, 14, and 17-22 is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: 6/7/04

By: 

James M. Urzedowski
Registration No.: 48596

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

F:\wpwork\jmu\10015us01-amd-20040526.doc